

ORAL ORDER re 52 Joint Motion for Teleconference to Resolve Protective Order Dispute. Having considered the parties's letter submissions (D.I. 64; D.I. 65), IT IS ORDERED that Defendants's proposed language at ¶ 10.2.2 of the proposed stipulated Protective Order is ADOPTED. (D.I. 65, Ex. 1 at 24) Plaintiffs argue that the prosecution bar should be narrowly limited to drafting and amending patent claims in the IPR proceedings, whereas Defendants take the position that the prosecution bar should also extend to drafting motions to amend the patent claims and arguing the patentability of claims presented in a motion to amend. (Id.) Case authority from this district recognizes that, "even though claims may only be narrowed in post-grant proceedings, the risk associated with the improper use of confidential information is that the patent prosecutors can arrange to strategic[ally] narrow claims to avoid prior art while still capturing the defendants's products." *British Telecommcns PLC v. IAC/InterActiveCorp*, C.A. No. 18-366-WCB, 330 F.R.D. 387, 396 (D. Del. 2019) (internal quotation marks omitted). Plaintiffs have not adequately addressed how litigation counsel with access to highly confidential information can avoid these risks under the terms of Plaintiffs's proposed prosecution bar. Plaintiffs do not offer examples or otherwise explain how litigation counsel could draft a motion to amend the patent claims and argue the patentability of the amended claims in IPR proceedings without any involvement in or communication with prosecution counsel about the amended claims. Under these circumstances, it seems that allowing litigation counsel's involvement in limited aspects of the claim amendment process could defeat the purpose of implementing the prosecution bar in the first place. Defendants's proposal is consistent with the balanced approach adopted in *British Telecommunications* because it allows litigation counsel to participate in IPR proceedings except as to activities directly related to the drafting or amendment of claims in those proceedings. Id. at 396-97 (adopting prosecution bar that permits litigation counsel "to participate in post-grant review but not to participate in drafting or amending claims (or consulting with those who do)" to avoid "the greatest risk of misuse of the litigation opponent's confidential information"). On or before May 8, 2024, the parties shall docket a proposed stipulated Protective Order that complies with this ruling for the Court's signature. IT IS FURTHER ORDERED that the discovery dispute teleconference scheduled for May 9, 2024 at 3:00 p.m. is CANCELLED. Ordered by Judge Sherry R. Fallon on 5/7/2024. (lih) (Entered: 05/07/2024)

As of May 8, 2024, PACER did not contain a publicly available document associated with this docket entry. The text of the docket entry is shown above.

Aerin Medical Inc. et al v. Neurent Medical Inc. et al
1-23-cv-00756 (DDE), 5/7/2024, docket entry 66